



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

1-5

APPLICATION NO.	FILING DATE	FIRST NAME INVENTOR	ATTORNEY DOCKET NO.	INFORMATION
09/723,098	11/27/2000	Medasser H-Stouhary	13063	5328

7800  
12/11/2001  
Scott D. Locke, Esq.  
Kalow & Springut, LLP  
19th Floor  
488 Madison Avenue  
New York, NY 10022

EXAMINER

YOON, TAI H

ARTICLE PAPER NUMBER

14

3

DATE MAILED 12/11/2001

Please find below and or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/123,098

Applicant(s)

El-Shoukary et al

Examiner

T. Yoon

Group Art Unit

1714

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-38 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-38 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1714

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 14-29 and 34-37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DE 1234234.

DE teaches the instant pigments treated with an organic-acid phosphate compound in examples 3 and 4 which meets the instant formula of claim 3. Dried pigments and various acids are taught at page 1, lines 4 and 23-26 of the translated paper.

Also, a invention in a product-by-process claim is a product, not a process. See *In re Brown*, 459 F2d 531, 173 USPQ 685 (CCPA 1972) and *In re Thorpe*, 777 F2d 695, 697, 227 USPQ 964 (Fed. Cir. 1985).

Thus, the instant invention lacks novelty.

Art Unit: 1714

Claims 1, 2, 4, 6, 8, 10, 12, 14, 18, 20, 22, 24, 26, 28, 30, 32 and 34-38 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stramel (US 5,397,391).

Stramel teaches the instant pigments treated with an organic-acid phosphate compound at col. 4, lines 16-40 and in examples which inherently meets the instant reaction products. Pre-treated pigments are taught at col. 3, lines 41-53 and methods of making phosphate esters treated pigments are taught at col. 3, lines 33-40 (spray drying), 54 to col. 4, lines 15. The intensifier bar of a V-blender meets the instant micronization. Also, the matrix resins such as polyethylene (col. 4, line 62) and an amount of pigments therein (col. 5, lines 29-33) are taught.

Thus, the instant invention lacks novelty.

Claims 1-9, 14, 15, 18-29 and 34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Menovcik et al (US 5,876,493).

Menovcik et al teach the instant pigments treated with an organic-acid phosphate compound at col. 3, lines 1-22. The method of treatment and pre-treated pigments are taught at col. 1, lines 52-57 and col. 3, lines 62-63.

Thus, the instant invention lacks novelty.

Claims 1-38 are rejected under 35 U.S.C. 103(a) as obvious over DE 1234234 in view of Stramel (US 5,397,391), Menovcik et al (US 5,876,493) or Herget et al (US 6,270,563).

Art Unit: 1714

The instant invention further recites pre-treated pigments over DE. However, such pre-treated pigments are well known in the art as taught by Stramel (col. 4, lines 16-40), Menovcik et al (col. 3, lines 62-63) and Herget et al (col. 3, lines 5-14)

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize the art well known pre-treated pigments of DE or Menovcik et al or Herget et al in DE as pigments since such pre-treated pigments are well known in the art and since pigments of DE encompass any pigment.

Claims 1-7, 14-31 and 34-37 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Johnson ~~et al~~ (US 5,466,482).

Johnson ~~et al~~ teach the instant pigments treated with an organic-acid phosphate compound in abstract and at col. 1, lines 34-63. Hydrogen as M and C<sub>6</sub> alkyl (hexyl) as R, for example meet the instant formula. Various methods (col. 4, lines 26-52), TiO<sub>2</sub> (col. 4, lines 63-64) and polyolefins (col. 5, lines 14-15) are taught also.

Thus, the instant invention lacks novelty.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Monday to Thursday from 8:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Application/Control Number: 09/723,098

Page 5

Art Unit: 1714

Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

THY/December 6, 2001



**TAE H. YOON**  
**PRIMARY EXAMINER**